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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,682	06/11/2001	Limor Schweitzer	XACTP005	5002
28875	7590	08/24/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER

3693

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/879,682

Applicant(s)

SCHWEITZER, LIMOR

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>no new ids</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 7, 15 & 35 under 35 USC 112.

The Applicant attention is re-drawn to the following:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7, 15 & 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Re claim 7:**

*Transferring the payment from a pervious debit account before enabling the debit account in response to the request.*

It is unclear to the examiner what the “previous debit account” is. For the purposes of examination the claim will be interpreted as:

“Transferring the payment from a first existing customer bank debit account before enabling the pre-paid second phone debit account in response to the request.”

In view of the applicant’s amendments & explanations the 112 rejections for claim 15 & 35 is hereby withdrawn.

***Claim Rejections - 35 USC § 101***

In view of the applicants amendments the 101 rejections is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claims 1-36 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 & 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice.

**Re claim 1 & 18:** Hultgren discloses:

*A method and program for providing a digital wallet for IP usage utilizing a wireless network, comprising:*

*Prior to allowing usage, receiving a request for a pre-paid debit account (Hultgren, Figure 3A, Item 300, it is inherent that would you obtain a customer identification for those that request the payment transfer service or debit account)*

*Prior to allowing usage, enabling pre-paid debit account (Hultgren, Figure 3A, Items 306, 314 & 316, these are all three more specific steps of enabling the payment transfer service or debit account)*

*Collecting payment over wireless network billing debit account (Hultgren, Figure 3B, Item 328, 334 & 348, it is inherent that the collection is completed with the financial institution.)*

*Collecting payment against debit account with IP over wireless network* (Hultgren, Figure 3B, Item 330, 334 & 348, it is inherent that the collection is completed with the financial institution.)

Although Hultgren does specifically disclose payment for mobile phone usage It is inherent that any utility including a mobile phone company is disclosed in Hultgren. Hultgren specifically uses the example of “utility bill, for example” (column 4, line 50)

**Re claim 2 & 19:** Hultgren discloses:

*Request received via mobile cellular hand set and debit account is enabled by human operator* (Hultgren, Figure 1, Item 60)

**Re claim 3 & 20:** Hultgren discloses:

*Wireless network via a mobile cellular handset* (Hultgren, Figure 1, Item 50)

**Re claim 4 & 21:**

*Uses WAP*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that WAP is a commonly used protocol for developing wireless applications and could be used for developing a mobile payment system.

**Re claim 5 & 22:** Hultgren discloses:

*IP includes data transfer* (Hultgren, Figure 1, Item 50)

**Re claim 6 & 23:** Hultgren discloses:

*IP usage includes payment for good or services* (Hultgren, Figure 3)

**Re claim 7 & 24:** Hultgren discloses:

*Transferring the payment from a first existing customer bank debit account before enabling the pre-paid second phone debit account in response to the request. (Hultgren, Figure 3A, Items 306, 314 & 316)*

**Re claim 8 & 25:** Hultgren discloses:

*Balance is updated in real-time (Hultgren, column 9, line 36-47, “immediately transfer funds”)*

**Re claim 9 & 26:** Hultgren discloses:

*Alert is sent to a user when below predetermined amount ?? (Hultgren, column 7, line 40-47, “invalid transaction notification”)*

**Re claim 10 & 27:** Hultgren discloses:

*Discontinued usage upon the debit account falling below a predetermined amount (Hultgren, Figure 3A, Items 318)*

**Re claim 11 & 28:** Hultgren discloses:

*Payment is received via a credit account (Hultgren, Figure 3A, Items 306, 314 & 316)*

**RE: Claims 12-15 & 29-32**

Claims 12-15 & 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472.)

**Re claim 12 & 29:** Foladare discloses:

*Limiting usage based on user-defined threshold (Foladare, Figure 1, Item 104)*

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & official notice does not specifically disclose user-defined threshold. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 13 & 30:** Foladare discloses:

*Threshold expires after a pre-determine time limit*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that any variable set by the user can have time limits associated with it. This is just good business practice to never have user inputs without time limitations on these inputs.

**Re claim 14 & 31:** Foladare discloses:

*User-defined threshold limitation expires upon receipt of a key* (Foladare, Figure 1, Item 116, authorization – either through a key or other method)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user-defined threshold limitation. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold limitation as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 15 & 32:** Foladare discloses:

*User may authorize payment of another users wireless network voice communication and IP usage upon receipt of the key by said user* (Foladare, Abstract, "ancillary credit or debit card")

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user key. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user key as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**RE: Claims 16-17 & 33-34**

Claims 16-17 & 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472) in further view of Holm-Blagg (US PG Published 2004/0030657 A1)

**Re claim 16 & 33:** Holm-Blagg discloses:

*Plural users may use wireless network voice communication and IP using a single debit account* (Holm-Blagg, Figure 2, account 1 & 5, etc)

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe plural users. Holm-Blagg clearly discloses a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.



It is clear that one would be motivated to add flexibility to the process.

**Re claim 17 & 34:** Holm-Blagg discloses:

*Limiting the usage for each of the users based on a single threshold associated with the debit account (Holm-Blagg, Figure 7B, "available credit line")*

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.

It is clear that one would be motivated to add flexibility to the process.

### ***Response to Arguments***

Applicant's arguments filed 06/09/2006 have been fully considered but they are not persuasive.

In particular with respect to 112 the Applicant argued "previous debit account" should be interpreted as a debit account that is previously provided. This still is unclear to the examiner and has provided no true explanation. The examiner has tried to once again interpret the claim. If the applicant is trying to explain that many users will have a first already existing debit account with a bank that they will use to establish the "mobile phone usage or second account" then this should be explained in more detail. If this is not what the applicant is trying to claim then the examiner would need more explanation.

With respect to Claim 1 the Applicant argued 1<sup>st</sup>: item 300 in Figure 3A from Hultgren... simply fails to disclose, “receiving a request for a debit account” as claimed by the applicant.

The Examiner refutes the argument made by the Applicant and draws the attention to back to Hultgren the examiner further explains that it is inherent that would you obtain a customer identification for those that request the payment transfer service or debit account. In addition, “receiving a request for a debit account” would be included in practically all prior art that includes a debit account, you would not establish an account unless the customer request it.

Applicants argued 2<sup>nd</sup>, Hultgren fails to disclose, “enabling the ... debit account in response to the request”

The Examiner refutes the argument made by the Applicant and draws the attention to back to Hultgren items 306, 314 & 316 all of these steps outline enabling the process. The examiner is interpreting the broadest reasonable interpretation and these step certainly would include enabling the process.

Applicants argued 3<sup>rd</sup>, Hultgren fails to disclose, “collecting payment for... wireless network voice communication over the network by billing against the debit account”

The Examiner refutes the argument made by the Applicant and draws the attention to Hultgren, Figure 3B, Item 328, 334 & 348, it is inherent that the collection is completed with the financial institution.

Applicants argued 4<sup>th</sup>, Hultgren fails to disclose, “collecting payment for ... IP usage by billing against the .. debit account wherein IP usage is carried out using the wireless network.”

The Examiner refutes the argument made by the Applicant and draws the attention to Hultgren, Figure 3B, Item 328, 334 & 348, it is inherent that the collection is completed with the financial institution.

Applicants argued 5<sup>th</sup>, use of official notice and that Hultgren discloses “facilitates payment from a customer account to a merchant account” and that Hultgren teaches away in teaching that compares “GPS locations...”

The Examiner refutes the argument made by the Applicant and explains in further review of the prior art believe that payment of phone service is included directly in the reference and inherent in that it clearly states “utility bill, for example” (column 4, line 50). Additionally, the examiner argues that because Hultgren has additional features is not an indication that it is teaching away for the reference.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

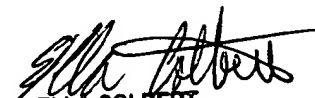
### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

  
ELLA COLBERT  
PRIMARY EXAMINER